

REMARKS

I. INTRODUCTION

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

II. REQUEST FOR INTERVIEW

Applicants' representatives contacted Examiner Pizarro-Crespo to discuss the patentability of the claimed invention and to advance prosecution by discussing the outstanding rejections. However, the Examiner indicated that he was unwilling to grant an interview since the final action has been issued. Since an RCE is being filed herewith, Applicants hereby renew their request for a personal interview prior to consideration of the present amendment.

If any future rejections are to be made against the claims, it is respectfully requested that the Examiner contact Applicants' representative at the below-listed number so that prosecution may be advanced in a timely and effective manner.

III. STATUS OF THE CLAIMS

Claims 1-23 are pending; Claims 1, 2, 10-12, 21, and 22 are active; and Claims 3-9, 13-20, and 23 stand withdrawn from consideration. No claims are newly added, amended, or cancelled herewith.

IV. SUMMARY OF THE OFFICE ACTION

In the outstanding Office Action, Claim 23 was withdrawn as directed to a non-elected species; the title of the invention was objected to; Claims 1, 2, and 10-12 were rejected under 35 U.S.C. § 102(b) as anticipated by *Kim* (U.S. Patent No. 6,225,688); and Claims 1, 21, and 22

were rejected under 35 U.S.C. § 102(e) as anticipated by *Moon* (U.S. Patent Publication No. 2002/0030975).

V. ARGUMENTS

A. Objection to the Title

In the outstanding Office Action, the title of the invention was objected to as not descriptive. In response, the title of the invention has been amended herewith to “Multilayer Circuit Including Stacked Layers of Insulating Material and Conductive Sections.”

Accordingly, it is respectfully submitted that this objection is overcome and it is respectfully requested that it be withdrawn. If the Examiner disagrees, it is respectfully requested that the Examiner provide a proposed amendment to the title with the next Office Action.

B. Rejections Under 35 U.S.C. § 102

1. The Kim Rejection

Claims 1, 2, and 10-12 stand rejected under 35 U.S.C. § 102(b) as anticipated by *Kim*. For the reasons discussed below, this rejection is respectfully traversed.

a. The Outstanding Office Action Does Not Address the Claimed Features

Claim 1 recites:

A multilayer circuit comprising a flexible sheet of insulating material having two sides, wherein conductive sections are attached to both of said two sides,

wherein said flexible sheet is folded along folding lines, which divide said flexible sheet into consecutive segments, in order to form a multilayer structure having conductor layers formed by the conductive sections and insulator layers of the flexible sheet of insulating material stacked above each other, the conductive sections being interconnected to form an electric circuit,

wherein at least two consecutive sections of the electric circuit that must

be insulated from each other are disposed on different sides of said flexible sheet.

Claims 2 and 10-12 depend from Claim 1.

The outstanding Office Action alleges that *Kim* discloses every feature recited in Claim 1. However, the outstanding Office Action does not address each and every feature of Claim 1.

For example, the outstanding Office Action does not address in any way the claimed feature “at least two consecutive sections of the electric circuit that must be insulated from each other are disposed on different sides of said flexible sheet.” It is respectfully submitted that this feature is not disclosed or suggested by *Kim*. Certainly, the Office Action has not cited to any teachings within *Kim* to anticipate this feature. As a result, the outstanding Office Action has not provided a *prima facie* case of anticipation, and it is respectfully requested that this rejection be withdrawn.

b. The Outstanding Office Action Appears to Allege that Certain Claimed Features Are Inherent Without Satisfying the Requirements Set Forth in MPEP § 2112

In addition, the outstanding Office Action does not address the claimed feature “a flexible sheet of insulating material having two sides,” which is recited in Claim 1. Instead, the Office Action appears to assert that the substrate 310 of *Kim* is inherently insulative. The Office Action further alleges that the conductive sections of *Kim* are inherently interconnected to form an electric circuit and cites to Figure 15 of *Kim* to support this assertion. *Office Action*, page 3. However, it is respectfully submitted that the outstanding Office Action has not satisfied the burden of proof for inherency.

As set forth in MPEP § 2112, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or

characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Moreover, “[i]nherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In this case, it is respectfully submitted that none of the criteria set forth in MPEP § 2112 has been satisfied, as the Office Action has not pointed to any teachings or technical reasoning to show that the claimed flexible sheet of insulating material is necessarily present in *Kim*. Similarly, the Office Action cites to no description in *Kim* or other technical reasoning to support the assertion that the conductive sections of *Kim* are necessarily interconnected to form an electric circuit. Accordingly, it is respectfully submitted that the Office Action has not provided a *prima facie* case of anticipation in accordance with MPEP § 2112, and it is respectfully requested that this rejection be withdrawn.

c. The Rejection Improperly Mixes Elements from Different Embodiments in the Applied Reference

Additionally, in support of the present rejection, the outstanding Office Action cites to both Figures 15 and 24 of *Kim*, which represent different embodiments. *Office Action*, pages 3 and 5. Accordingly, it appears that the outstanding Office Action is mixing elements of multiple embodiments while attempting to develop a *prima facie* case of anticipation.¹ The Office Action

¹ Even assuming, *arguendo*, that individual elements of the different embodiments could be combined as the

does not provide any technical reasoning or cite to any support within *Kim* to explain how these different embodiments would be properly combinable. Thus, it is important to note that (1) the outstanding Office Action has tacitly admitted that the claimed invention is not disclosed or suggested by any individual embodiment of *Kim* and (2) has not cited to any teachings in *Kim* to support the modifications to the individual embodiments proposed by the Office Action.

2. *The Moon Rejection*

The outstanding Office Action further rejects Claims 1, 21, and 22 as anticipated by *Moon*. For the reasons discussed below, this rejection is also respectfully traversed.

a. The Office Action Does Not (and Cannot) Provide Any Support for the Rejections within the Text of the Cited Reference

At pages 4-5 of the outstanding Office Action, the Office Action alleges that every feature of Claim 1 is disclosed by *Moon*. However, the Office Action cites to figures (without any explanation) in support of the rejection, rather than any written description. Because the written description of *Moon* does not support the outstanding rejection, it is respectfully submitted that the Office Action has not provided a *prima facie* case of anticipation.

b. The Inherency Requirements of MPEP § 2112 Are Not Met

The Office Action alleges that *Moon* describes a flexible sheet of insulating material. In support of this assertion, the Office Action cites to element 131 of *Moon*. However, there is no description in *Moon* to support the allegation that element 131 is made of an insulating material. If the Office Action is alleging that element 131 is inherently made of insulating material, it has not satisfied the burden of proof required by MPEP § 2112. Accordingly, it is respectfully

outstanding Office Action alleges, the outstanding Office Action has not provided a *prima facie* case of anticipation for at least the reasons explained above.

requested that this rejection be withdrawn.

- c. *Moon does not disclose or suggest "at least two consecutive sections of the electric circuit that must be insulated from each other are disposed on different sides of said flexible sheet," as recited in Claim 1*

Likewise, the Office Action cites to Figure 3A of *Moon* as teaching "at least two consecutive sections of the electric circuit that must be insulated from each other are disposed on different sides of said flexible sheet." Again, no text within *Moon* is cited to support this interpretation of Figure 3A.

In fact, *Moon* describes that ball pad arrays 139a and 139b are located at the outer sides of the sandwich. These ball pad arrays include ball pads 143 adapted to be connected to the first and second contacts of the first and/or second contact arrays by interconnecting circuitry 144. *Moon*, para. [0039]. Dies 110 and 120 are located within the "sandwich" configuration illustrated in Figure 3A of *Moon*. *Moon*, para. [0035]. *Moon* does not disclose or suggest that dies 110 and 120 are "at least two consecutive sections of the electric circuit that must be insulated from each other," as recited in Claim 1, and the Office Action does not provide any reasoning to support its rejection.

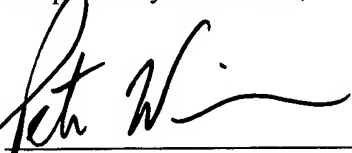
Thus, as the outstanding Office Action has not provided a *prima facie* case of anticipation with respect to Claims 1, 21, and 22 for at least the reasons discussed above, it is respectfully requested that the rejection of these claims be withdrawn.

VI. CONCLUSION

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Please charge any shortage or credit any overpayment of fees to Deposit Account No. 23-2185 (116598.00113). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicant hereby petitions under 37 C.F.R. §1.36 (a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

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